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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,835	08/25/2000	Scott Koenig	469201-493	4179

7590 07/01/2002  
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EXAMINER
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KAM, CHIH MIN

ART UNIT	PAPER NUMBER
1653	15

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/645,835

Applicant(s)

KEONING ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-30 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) 9-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 25-30 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The finality of the rejection of last office action is withdrawn because a new ground rejection of claims 25-30 and 33-35 under 35 U.S.C.112, second paragraph, has been made.

***Status of the Claims***

2. Claims 9-30 and 33-37 are pending.

Applicants' amendment and response filed on May 22, 2002 (Paper No. 13) has been entered and fully considered. Claims 31 and 32 have been canceled, and claims 9-24 remain withdrawn from consideration. Claims 25-30 and 33-37 are examined.

**Rejection Withdrawn**

***Claim Rejections - 35 USC § 112***

3. The previous rejection of claims 25-37 under 35 U.S.C.112, second paragraph, regarding the 75%, 90%, 95% and 25% sequence identity to the parent sequences, is withdrawn in view of applicants' cancellation of claims 31 and 32, applicants' amendment to the claim, and applicants' response at pages 3-4 in Paper NO. 13.

***Claim Rejections - 35 USC § 102***

4. The previous rejection of claims 31 and 32, under 35 U.S.C.102(a) as being anticipated by Spellerberg *et al.* (Infection and Immunity 67, 871-868 (1999)), is withdrawn in view of applicants' cancellation of the claim.

***Claim Rejections - 35 USC § 103***

5. The previous rejection of claims 31, 32 and 37, under 35 U.S.C.103(a) as being unpatentable over Spellerberg *et al.* in view of Bentle *et al.* (US 4,694,073), is withdrawn in view

of applicants' cancellation of claims 31 and 32, applicants' amendment of claim 37, and applicants' response at pages 4-5 in Paper No. 13.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-30 and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25, for example is indefinite because of the use of the term "75% identical to the sequence of SEQ ID NO:4". The term "75% identical to the sequence of SEQ ID NO:4" renders the claim indefinite, it is unclear whether the polypeptide sequence is identical to SEQ ID NO:4 or has 75% sequence homology to SEQ ID NO:4 as to "75% identical". The term "identical" is an absolute term, use of "sequence homology" or "sequence identity" is suggested. See also claims 26-28 and 33-35. Claims 29, 30 and 36 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

7. Claims 33-36 are indefinite because the amino acid sequence of Sp36 is not identified with a "SEQ ID NO:", it is not clear which amino acid sequence of Sp36 is used for comparison. Claims 34-36 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

In response, applicants indicate the amino acid sequence of Sp36 is identified as SEQ ID NO:7", however, the claim does not recite the sequence identifier. Recitation of "SEQ ID NO:7" is suggested.

**Conclusion**

8. Claims 25-30 and 33-36 are rejected. It appears claim 37 is free of prior art and is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

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June 20, 2002

*Karen Cochrane Carlson*  
KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER